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EXAMINER

SHAN, APRIL YING

ART UNIT

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2135

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/715,597	<b>Applicant(s)</b> SHAMOON ET AL.	
	<b>Examiner</b> APRIL Y. SHAN	<b>Art Unit</b> 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-21 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-21, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 May 2008 has been entered.
2. Claims 8 and 27 have been amended. Claims 1-7 and 22-26 have been canceled. Claim 29 is withdrawn from consideration due to restriction requirement. No new claims have been added. Claims 8-21 and 27-29 are currently pending in the present application. Claims 8-21 and 27-28 have been examined.
3. Applicant's amendments and argument have been fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via amendments.
4. Any objection/rejection not repeated below is withdrawn due to Applicant's amendment.

***Claim Rejections - 35 USC § 103***

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 8-21 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warren et al. (U.S. Patent No. 5,963,909) and in view of McRae (U.S. Patent No. 5,905,797)

As per **claim 8**, Warren et al. discloses a streaming media player providing content protection and digital rights management, including:

a port configured to receive a digital bit stream, the digital bit stream including:

content which is encrypted at least in part ("Fig. 12 is a block diagram of a multi-media data stream having a sequence of encrypted and unencrypted frames..." – e.g. col. 4, lines 13-16).

at least two sub-streams which have been muxed together (e.g. fig. 16), at least one of the sub-streams including compressed information ("...The data signal may comprise compressed digital data..." – e.g. col. 2, lines 26-35) and

a secure container including control information for controlling use of the content, including at least one key suitable for decryption of at least a portion of the content ("...With encrypted frames of multi-media data, encryption keys may be carried in a key layer with the encrypted data signal or another data signal for use in decryption..." – e.g. abstract and "...such that each packet contains an encryption key for decrypting..." – e.g. col. 3, lines 8-29, fig. 12 and fig. 13) ; a control arrangement including:

means for opening secure containers and extracting cryptographic keys (e.g. col. 3, lines 19-29 and col. 14, line 33 – col. 14, line 8)

means for decrypting the encrypted portion of the content ("Decryption 1740" in fig. 17); and

a demux designed to separate and route the sub-streams ("Fig. 4...The combined data stream is demultiplexed at demultiplexer 405 to separate the video data and SMT data..." - e.g. col. 8, lines 35-46 and Demux 405 in fig. 4. Please note Demux 405 in fig. 4 also routes CH. A 409, CH. B 412 and CH. C 411 in fig. 4); a decompression unit configured to decompress at least one of the

sub-streams (“...it will be processed by a decompressor 440 to provide an uncompressed digital or analog multi-media output...” – e.g. col. 10, lines 21-30 and fig. 4) the decompression unit and the demux being connected by a pathway for the transmission of information (e.g. fig. 4);

a rendering unit designed to process decompressed content information for rendering (“uncompressed multi-media output for playing (Ch. A)” in fig. 17); and

a stream controller (selector 435 in fig. 4) operatively connected to the decompression unit and the control arrangement, the stream controller including decryption functionality configured to decrypt at least a portion of a sub-stream based on at least one key passed from the control arrangement and pass the decrypted sub-stream to the decompression unit (e.g. fig. 17).

Warren et al. further discloses “...is compared with a Valid Copy Threshold (VCT). The VCT indicates the number of allowed copies and can be factory set into the player/recorder 150...” – e.g. col. 10, lines 61-66. To a person with ordinary skill in the art, VCT is a rule governing at least one aspect of usage of at least one sub-stream or object and stored in the player/recorder 150 by the factory.

Warren et al. does not expressly disclose the rule or rule sets stored in a non-volatile memory internally integrated with the player.

However, McRae discloses such well known feature in fig. 1 and in col. 3, lines 56-67. Please note in fig. 1, Non-volatile memory (NURAM) 9 is internally integrated with the player.

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate McRae's the rule or rule sets stored in a non-volatile memory internally integrated with the player into Warren et al. motivated by to store up to 8kb of data (i.e. rule or rule sets) for up to one year without external power (e.g. McRae, col. 3, lines 34-36).

As per **claim 9**, Warren et al. – McRae discloses a player as applied above in claim 8. Warren et al. further discloses wherein the rule or rule set includes at least one rule that is delivered from an external source (“...a Valid Copy Threshold (VCT)...and can be a factory set into the player/recorder 150” – e.g. col. 10, lines 61-66. Please note factory corresponds to Applicant's external source).

As per **claim 10**, Warren et al. – McRae discloses a player as applied above in claim 9. Warren et al. further discloses at least one rule is delivered as part of the digital bit stream (“...a Valid Copy Threshold (VCT)...or embedded in the SMT data” – e.g. col. 10, lines 61-66).

As per **claim 11**, Warren et al. – McRae discloses a player as applied above in claim 8. Warren et al. further discloses wherein the rule or rule set specifies conditions under which the governed sub-stream or object may be decrypted (e.g. col. 2, lines 26-35).

As per **claim 12**, Warren et al. – McRae discloses a player as applied above in claim 8. McRae further discloses wherein the rule or rule set governs at least one aspect of access to the governed sub-stream or object (e.g. col. 3, lines 56-67 and col. 4, line 50 – col. 5, line 13).

As per **claim 13**, Warren et al. – McRae discloses a player as applied above in claim 8. Warren et al. further discloses wherein the governed aspect includes making copies of the governed sub-stream or object (e.g. col. 10, lines 61-66).

As per **claim 14**, Warren et al. – McRae discloses a player as applied above in claim 8. Warren et al. further discloses wherein the governed aspect includes transmitting the governed sub-stream or object through a digital output port (e.g. “output (CH. B) and output (CH. C) in fig. 4 and fig. 17).

As per **claims 15-16**, Warren et al. further discloses wherein the rule or rule set specifies that the governed sub-stream or object can be transferred to a second device, but rendering of the governed sub-stream or object must be disabled in the player prior to or during the transfer and wherein the second device includes rendering capability,



lacks at least one feature present in the streaming media player, and is at least somewhat more portable than the streaming media player (e.g. col. 9, line 66 – col. 11, line 16, fig. 3, fig. 4 and col. 8, lines 35-67)

As per **claim 17**, Warren et al. - McRae discloses a player as applied above in claim 11. Warren et al. further discloses wherein the control arrangement contains at least two rules governing access to or use of the same governed sub-stream or object (“...master tag information...control tag information...” – e.g. col. 2, lines 35-47 and “additional generation of control tag information” – e.g. col. 2, lines 17-25).

As per **claims 18-19**, Warren et al. – McRae discloses a player as applied above in claim 17. Warren et al. further disclose wherein a first of the two rules was supplied by a first entity, and the second of the two rules was supplied by a second entity and wherein the first rule controls at least one aspect of operation of the second rule (e.g. col. 2, lines 35-47 and col. 2, lines 17-25)

As per **claim 20**, Warren et al. – McRae discloses a player as applied above in claim 8. McRae further discloses wherein the governed aspect includes use of at least one budget (e.g. col. 3, lines 56-67 and col. 6, lines 11-18)

As per **claim 21**, Warren et al. – McRae discloses a player as applied above in claim 8. McRae further discloses wherein the governed aspect includes a requirement that audit information be provided (e.g. col. 3, lines 56-67).

As per **claim 27**, Warren et al. – McRae discloses a player as applied above in claim 8. Warren et al. further discloses wherein the rule or rule set is configured to condition viewing information in at least one sub-stream upon viewing information in another sub-stream (e.g. col. 15, lines 9-23 and col. 8, lines 5-13).

As per **claim 28**, Warren et al. – McRae discloses a player as applied above in claim 27. McRae further discloses at least one sub-stream comprises an advertisement (e.g. col. 6, lines 19-37).

### ***Double Patenting***

8. Claims 8-21 and 27-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27-46 of copending Application No. 11/747,781 (U.S. Patent Application Publication 20070211891). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 27-46 in the copending application encompass the same subject matter as claims 8-21 and 27-28 in the application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. The subject matter claimed in the instant application is fully claimed in the referenced copending application and would be covered by any patent granted on that

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copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

The instant application claims a streaming media player providing content protection and digital rights management, including: a port configured to receive a digital bit stream, the digital bit stream including: content which is encrypted at least in part, at least two sub-streams which have been muxed together, at least one of the sub-streams including compressed information, and a secure container including control information for controlling use of the content, including at least one key suitable for decryption of at least a portion of the content; a control arrangement including: means for opening secure containers and extracting cryptographic keys, means for decrypting the encrypted portion of the content; and a rule or rule set governing at least one aspect of usage of at least one sub- stream or object, wherein the rule or rule set includes at least one rule stored in a non-volatile memory internally integrated with the player; a demux designed to separate and route the sub-streams; a decompression unit configured to decompress at least one of the sub-streams, the decompression unit and the demux being connected by a pathway for the transmission of information; a rendering unit designed to process decompressed content information for rendering; and a stream controller operatively connected to the decompression unit and the control arrangement, the stream controller including decryption functionality configured to decrypt at least a portion of a sub-stream based on at least one key passed from the control arrangement and pass the decrypted sub-stream to the decompression unit.

(Claim 1).

The co-pending application claims A streaming media player providing content protection and digital rights management, the streaming media player including: a port configured to receive at least: a digital bit stream, the digital bit stream including: digital content, one or more cryptographic keys configured to decrypt the digital content, and one or more rules configured for use in governing access to or other use of the digital content; and a control block including: means for extracting the one or more cryptographic keys from the digital bit stream, means for decrypting the digital content using the one or more cryptographic keys, and means for governing access to or other use of the digital content in accordance with the one or more rules; and an output for presenting the digital content to a user of the streaming media player (Claim 34).

10. Claims 8-21 and 27-28 of the instant application are envisioned by copending Application No. 11/747,781's claims 27-46 in that claims 27-46 of the copending application contain all the limitations of claims 8-21 and 27-28 of the instant application therefore are not patently distinct from the copending application claims and as such are unpatentable for obvious-type double patenting because although the wordings are slightly different, the instant application is about a streaming media player providing content protection and digital rights management and the co-pending application is about the same. It would have been obvious to a person with ordinary skill in the art to recognize that both applications are for stream media player providing content protection and digital rights management. The structures/the steps of both applications are similar and not patentable distinct.

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11. Claims 8-21 and 27-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-26 of copending Application No. 11/827,856 (U.S. Patent Application Publication 20080013724). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 23-26 in the copending application encompass the same subject matter as claims 8-21 and 27-28 in the application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. The subject matter claimed in the instant application is fully claimed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (PTO -892)

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/  
Examiner, Art Unit 2135

/H. S./  
Primary Examiner, Art Unit 2135